

Appl. No. 10/655,724
Amdt. dated April 4, 2005
Reply to Office action of January 3, 2005

Docket No. 29757/AG12-CIPC3

I. Status of the Claims

Claims 64-107 were pending prior to this response. By this response, no amendments are made to the claims. Thus, claims 64-107 remain pending.

II. Response to the January 3 Office Action

Claims 83 and 97 are rejected under 35 U.S.C. § 112, second paragraph, as being allegedly indefinite. Claims 64, 66-70, 83, 86-92, 95, 97, and 102-106 appear to be rejected under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 5,046,736 to Bridgeman et al. (hereinafter "Bridgeman").¹ Further, claims 65, 84, 98 and 99 are rejected under 35 U.S.C. § 103(a) as being allegedly unpatentable over Bridgeman in view of U.S. Patent No. 5,332,219 to Marnell et al. (hereinafter "Marnell"). In view of the following remarks, reconsideration of the application is respectfully requested.

A. The Section 112, second paragraph, rejection should be withdrawn

Applicants disagree that "value input device" (recited in claims 83 and 97) is indefinite. Value input devices can be found in the specification at paragraph [0028], and, by way of example, include "a coin slot 60, a bill validator 70, [and] a credit card receiver/terminal 75." That these input devices are "value" input devices is reflected in paragraph [0028], wherein it discusses items "of monetary value including coins, paper currency, tokens, or some form of credit indicator, such as a credit card." See also Fig. 1. Further support can be found at paragraph [0033], wherein it is discussed that the coin slot 160 and the bill validator 170 allow a player to "input monetary value." Applicant thus respectfully requests that this rejection be withdrawn.

¹ Different statements are made on pages 3-5 in regard to the claims that are subject to the rejection raised under section 102(b), and these statements conflict with the statements made regarding allowable subject matter on page 6, as addressed in greater detail below. The listing here reflects those claims particularly listed on pages 3-5 of the January 3 Office Action.

Appl. No. 10/655,724
Amdt. dated April 4, 2005
Reply to Office action of January 3, 2005

Docket No. 29757/AG12-CIPC3

B. The Section 102 and 103 rejections should be withdrawn

The presently pending claim set includes three independent claims (claims 64, 83, and 96) and forty-one claims that depend from one of these three independent claims (claims 65-82, 84-95 and 97-107, respectively). Applicants address the rejections separately as to each independent claim and the claims that depend therefrom.

1. Claims 64-82

Claim 64 recites a gaming device including a display screen that is capable of generating video images. The gaming device is programmed to select a first group of indicia from a plurality of indicia in a first game, the plurality of indicia including a plurality of playing indicia and at least one wild indicia, to cause a video image representing the first game to be displayed on the display screen, to provide a player with a winning advantage if the player receives the at least one wild indicia, and to limit the use of the at least one wild indicia.

In particular, claim 64 recites that the gaming device is programmed to select a first group of indicia from a plurality of indicia in a first game. The gaming device is also programmed to provide a player with a winning advantage if the player receives the at least one wild indicia and to limit the use of the at least one wild indicia.

At the outset, applicant notes that the rejection of claim 64 in the January 3 Office Action fails to address whether any of the limitations recited in the previous paragraph may be found in *Bridgeman*. As such, the January 3 Office Action fails to set forth a *prima facie* case of anticipation as to claim 64. On this basis alone, the rejection should be withdrawn.

However, applicant submits that, even if the allegations had been made that the particular limitations recited above can be found in *Bridgeman*, the rejection cannot stand. Applicant has reviewed *Bridgeman*, and has failed to find any disclosure, teaching or suggestion in regard to the limitations particularly recited above. For this reason as well, the rejection should be withdrawn.

As to claims 66-70, because *Bridgeman* fails to disclose each and every limitation of claim 64 from which these claims depend, *Bridgeman* also fails to disclose each and every limitation of these claims as well, at least for this reason. Moreover, as to claim 65, because

Appl. No. 10/655,724
Amdt. dated April 4, 2005
Reply to Office action of January 3, 2005

Docket No. 29757/AG12-CIPC3

Bridgeman fails to disclose each and every limitation of claim 64 from which this claim depends and Marnell does not provide the missing disclosure, then the combination of Bridgeman and Marnell fails to disclose, teach or suggest each and every limitation of this claim as well, at least for this reason. As to claims 71-82, the allowability of these claims was acknowledged in the January 3 Office Action, although these claims may be allowable for the reasons provided above relative to claim 64 as well.

Thus, claims 64-82 should be allowable, and the rejections should be withdrawn.

2. Claims 83-95

Claim 83 recites a gaming device including a display screen that is capable of generating video images, a selection device, and a value input device. The gaming device is programmed to determine that a player has used the value input device to make a wager, to provide a first group of playing indicia to define a first game, the first group of playing indicia being selected from a plurality of playing indicia, to provide at least one wild indicia for use in other than the first game, to cause a video image representing the first game to be displayed on the display screen, to determine that the player has used the selection device to reserve the at least one wild indicia for use in a subsequent game, to determine a first game outcome associated with the first group of playing indicia, and to determine a first payout according to a payout schedule, the first payout being associated with the first game outcome. The gaming device is also programmed to provide a subsequent group of playing indicia to define the subsequent game, the subsequent group of playing indicia being selected from the plurality of playing indicia, to determine that the player has used the selection device to combine the at least one wild indicia with the subsequent group of playing indicia to define a modified group of playing indicia, to determine a game outcome associated with the modified group of playing indicia, and to determine a subsequent payout associated with the game outcome associated with the modified group of playing indicia by modifying the payout for the game outcome associated with the modified group of playing indicia.

In particular, claim 83 recites that the gaming device is programmed to provide at least one wild indicia for use in other than the first game and to determine that the player has used the selection device to reserve the at least one wild indicia for use in a subsequent game. Claim 83 also recites that the gaming device is programmed to provide a subsequent group of

Appl. No. 10/655,724
Amdt. dated April 4, 2005
Reply to Office action of January 3, 2005

Docket No. 29757/AG12-CIPC3

playing indicia to define the subsequent game, to determine that the player has used the selection device to combine the at least one wild indicia with the subsequent group of playing indicia to define a modified group of playing indicia, to determine a game outcome associated with the modified group of playing indicia, and to determine a subsequent payout associated with the game outcome associated with the modified group of playing indicia by modifying the payout for the game outcome associated with the modified group of playing indicia.

At the outset, applicant notes that the rejection of claim 83 in the January 3 Office Action fails to address whether any of the limitations recited in the previous paragraph may be found in Bridgeman. As such, the January 3 Office Action fails to set forth a prima facie case of anticipation as to claim 83. On this basis alone, the rejection should be withdrawn.

However, applicant submits that, even if the allegations had been made that the particular limitations recited above can be found in Bridgeman, the rejection cannot stand. Applicant has reviewed Bridgeman, and has failed to find any disclosure, teaching or suggestion in regard to the limitations particularly recited above. For this reason as well, the rejection should be withdrawn.

As to claims 86-92 and 95, because Bridgeman fails to disclose each and every limitation of claim 83 from which these claims depend, Bridgeman also fails to disclose each and every limitation of these claims as well, at least for this reason. Moreover, as to claim 84, because Bridgeman fails to disclose each and every limitation of claim 83 from which this claim depend and Marnell does not provide the missing disclosure, then the combination of Bridgeman and Marnell fails to disclose, teach or suggest each and every limitation of this claim as well, at least for this reason. As to claims 85, 93, and 94, the allowability of these claims was acknowledged in the January 3 Office Action, although these claims may be allowable for the reasons provided above relative to claim 83 as well.

Thus, claims 83-95 should be allowable, and the rejections should be withdrawn.

Appl. No. 10/655,724
Amdt. dated April 4, 2005
Reply to Office action of January 3, 2005

Docket No. 29757/AG12-CIPC3

3. Claims 96-107

The purported rejections raised as to claims 96-107 conflict with the statements made as to those claims found to be allowable on page 6 of the January 3 Office Action. Consequently, applicant submits the following remarks in response.

Claim 96 is an independent claim. Despite this fact, the Office Action indicates that claim 96 is merely allowable, objected to as being dependent from a rejected base claim. Office Action, page 6. Given that no art rejection is made relative to claim 96, and given that claim 96 is allowable in its own right because it does not depend from a rejected base claim, claim 96 should be allowed. Moreover, claims 97-107 that depend from claim 96 should be allowable for at least this reason.

Applicants recognize that claims 97 and 102-106 are stated to be rejected as allegedly anticipated by Bridgeman and claims 98 and 99 as allegedly unpatentable over Bridgeman in view of Marnell. However, as noted above, claims 97-99 and 102-106 depend from claim 96. Thus, the rejection of claims 97-99 and 102-106 based on Bridgeman or the combination of Bridgeman and Marnell is directly contradicted by the fact that no rejection has been raised regarding claim 96. Therefore, claims 97-99 and 102-106 that depend from claim 96 cannot be anticipated by Bridgeman or unpatentable over the combination of Bridgeman and Marnell where claim 96 is not rejected. Consequently, for this reason as well, the rejections of claims 97-99 and 102-107 should be withdrawn.

Thus, claims 96-107 should be allowable, and the rejections should be withdrawn.

III. Conclusion

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to pass this application to issue. If there is any matter that the Examiner would like to discuss, the Examiner is invited to contact the undersigned representative at the telephone number set forth below.

Appl. No. 10/655,724
Amdt. dated April 4, 2005
Reply to Office action of January 3, 2005

Docket No. 29757/AG12-CIPC3

Dated: April 4, 2005

Respectfully submitted,

By 

Randall G. Rueth

Registration No.: 45,887

MARSHALL, GERSTEIN & BORUN LLP

233 S. Wacker Drive, Suite 6300

Sears Tower

Chicago, Illinois 60606-6357

(312) 474-6300

Attorney for Applicant